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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/866,593 | 05/30/2001 | John J. Ryan III | 274 | 4947 |

7590 05/13/2003

KRIEG DEVAULTLUNDY, LLP
825 Anthony Wayne Building
203 E. Berry Street
Fort Wayne, IN 46802

EXAMINER

MORRISON, NASCHICA SANDERS

ART UNIT PAPER NUMBER

3632

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,593

Applicant(s)

RYAN ET AL.

Examiner

Naschica S Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5-9,11-16,18-20 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,5-9,11-16,18-20 and 24-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This is the third Office Action for serial number 09/866,593, Insulating Wire Separator Apparatus for Piping Systems, filed on May 30, 2001. Claims 2, 3, 5-9, 11-16, 18-20, 24-29 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/20/03 has been entered.

Response to Amendment

The amendment filed 3/20/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "about sixty degrees" and "about eighty degrees" on lines 5-6 of the paragraph starting on page 21, line 7; "foot plate and earth anchor portion" on line 3 of the paragraph starting on page 21, line 14 (see also repetitive occurrences throughout the specification); "about three inches" and

"about six inches" on line 7 of the paragraph starting on page 21, line 18 (see also repetitive occurrences in the specification).

Applicant is required to cancel the new matter in the reply to this Office Action.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 24 recites, "a pair of conduit engaging sliding wedge surfaces" in lines 7, 10, etc. The terminology "sliding wedge" is not adequately supported or disclosed by the original specification.

Drawings

Drawings filed are approved

✓ The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) *not mentioned in the description*: "Q" in Figure 7A. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they *do not include* the following reference sign(s) mentioned in the description: reference numeral 180; 2-2 on page 4, line 22; 3-3 on page 5, line 3; 122 on page 7, line 7. A proposed drawing correction or corrected drawings are required in

keep
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reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

✓ **Claim Objections**

Claim 24 is objected to because of the following informalities: on line 23, delete "from said main conduit" after "safe distance". Appropriate correction is required.

Claim 25 is objected to because of the following informalities: on line 2, "a" should be --an--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2, 3, 5-9, 11-16, 18-20, and 24-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claims 7 and 28, the limitation "*about* sixty to *about* eighty degrees" is not found in the original specification and is not supported thereby. Regarding claim 11, the limitation "at *about* least two inches" is not found in the original specification and is not supported thereby. Regarding claim 8, the limitation "*about* three to *about* thirty degrees" is not found in the original specification and is not supported thereby. Regarding claim 24, the limitations

"a foot plate and earth anchor portion" in line 15 and "to resist rotation of said wire separator apparatus..." in lines 19-20 are not found in the original specification or supported thereby.

✓ ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "said other end of said arm portion" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "said other end of said arm portion" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2, 6, 24, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,601,260 to Shinohara et al. (Shinohara). With regards to claims 2, 6, 24, 26, 27, Shinohara discloses a wire support (Fig. 2) made of resin comprising: an elongated body (10 generally) having opposite ends, a resilient main

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conduit receiving portion (41 adjacent 14) at one end of the body having an inner radius sized to receive a conduit and a pair of conduit engaging sliding wedge surfaces (surfaces of 50 and 52 defining the opening/gap therebetween) on opposite sides of an opening (between 50 and 54A); an I-beam arm portion (extending between 20 and 14) extending away from the main conduit receiving portion (41 adjacent 14) on the side opposite the opening (between 50 and 54A) and extending to the opposite end of the elongated body a distance beyond the main conduit receiving portion; a plate and anchor portion (46 located between 41 and 52) extending generally perpendicularly from the arm portion in proximity to the conduit receiving portion (41 adjacent 14); a wire clip portion (41 adjacent 12) having a pair of fingers (50,52) and positioned ^{adjacent to} at the opposite end of the elongated body; and a separator post (30,40) extending generally perpendicular from the arm portion and spaced from the plate portion but in proximity to the wire clip portion, the arm portion extending beyond the separator post (30,40).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3, 5, 7, 8, 11, 19, 20, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara. Regarding claims 3 and 11, arguably Shinohara teaches the arm portion extending at least two inches beyond the separator post (30). Additionally, Shinohara does not explicitly teach the separator post spaced at least ten inches from the plate portion. However, it would have been obvious to one of ordinary

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skill in the art at the time the invention was made to have modified the arm portion and separator post to extend the specified distances since it has been held that a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claims 5 and 20, Shinohara does not disclose the wire support being color-coded. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the wire support to be any of various colors because one would have been motivated to provide a device that is aesthetically pleasing as is well known in the art.

Regarding claims 7, 8, 19, 28 and 29, Shinohara discloses the wire support as applied to claims 2, 6, 24, 26 and 27 above, but does not teach the opening (between 50 and 54A) being angled from about sixty to about eighty degrees from the centerline of a conduit or the wire clip finger portion (41 adjacent 12) being angled from about three to about thirty degrees from the centerline of the arm portion (20). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the opening of the main conduit receiving portion to be angled between about sixty and about eighty degrees or the wire clip finger portion to be angled between about three and about thirty degrees since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara in view of U.S. Patent 5,772,166 to Adams. With regards to claims 9 and 18,

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Shinohara discloses the wire support as applied above, but does not teach the main conduit receiving portion comprising first and second half radiused portions. Adams discloses a mounting clip comprising a main conduit receiving portion (Fig. 11) including a first half radiused portion (132) releasably fastened to a second half radiused portion (134) by a releasable fastener (140,142). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the main conduit receiving portion to include first and second half radiused portions releasably fastened together because one would have been motivated to provide a means for adjusting the position of the item secured therein as taught by Adams (col. 8, lines 13-20).

Claims 12-15 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara in view of U.S. Patent 5,018,260 to Ziu. With regards to claims 12-15 and 25, Shinohara discloses the wire support to claims 2, 3, 5-8, 11, 24, 26, and 27 as applied above, but does not disclose the main conduit receiving portion including a strengthening rib. Ziu discloses a wire clip comprising a main conduit receiving portion (18) including an outwardly extending rib (40) extending thereabout. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the wire support of Shinohara by including an outer rib extending between the conduit engaging surfaces and arm portion (i.e. the entire length of the conduit receiving portion) because one would have been motivated to provide a stronger gripping support as taught by Ziu (col. 5, lines 56-58).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara in view of Ziu and further in view of U.S. Patent 5,772,166 to Adams. With

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regards to claim 16, Shinohara in view of Ziu discloses the wire support as applied to claims 12-15 and 25 above, but does not teach the main conduit receiving portion comprising first and second half radiused portions. Adams discloses a mounting clip comprising a main conduit receiving portion (Fig. 11) including a first half radiused portion (132) releasably fastened to a second half radiused portion (134) by a releasable fastener (140,142). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the main conduit receiving portion to include first and second half radiused portions releasably fastened together because one would have been motivated to provide a means for adjusting the position of the item secured therein as taught by Adams (col. 8, lines 13-20).

Response to Arguments

Applicant's arguments filed 3/20/03 have been fully considered but they are not persuasive.

In response to applicant's argument of claim 3 that Shinohara does not teach or suggest the modification of adding a separator post, examiner must specify that Shinohara has not been modified to include a separator post as it already teaches this claimed element (see 102(b) rejection above). Additionally, Shinohara teaches the plate and anchor portion as recited in the rejection above. Regarding claim 5, the support for modifying the apparatus of Shinohara to be of a distinct color is provided by the knowledge generally available to one of ordinary skill in the art. Additionally, the claim language recites a single apparatus that is of a color and not to a system of

apparatuses wherein each apparatus has a different color. Regarding claim 9, the motivation to modify Shinohara in view of Adams is found in the teachings of Adams as clearly stated in the rejection cited above. Additionally, the first and second clip portions of Adams are relevant to all of the tubular-object-receiving clip/clamp members of the present invention and Shinohara.

In response to applicant's argument that Shinohara discloses a clamping means that requires a hole to be made in the mounting plate and the clamping means being inserted into that hole, thus teaching away from applicant's invention, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is *capable of performing the intended use*, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

2002/0190166 to Bagdi; 6513767 to Rodgers; 6513772 to Gary et al.

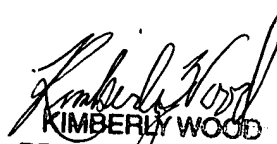
The above references disclose apparatuses relevant to applicant's invention.

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703) 305-0228. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax machine telephone number for the Technology Center is (703) 305-3598 (formal amendments) or (703) 308-3519 (informal communications).

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 308-2168.

Naschica S. Morrison
Patent Examiner
Art Unit 3632
5/6/03


KIMBERLY WOOD
PRIMARY EXAMINER